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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SISSON, BRADLEY L

ART UNIT PAPER NUMBER

1634

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/462,929

Applicant(s)

OLD ET AL.

Examiner

Bradley L. Sisson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67, 118, 121, 122 and 124-126 is/are pending in the application.
- 4a) Of the above claim(s) 121, 122, 125 and 126 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67, 118 and 124 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 November 2004 has been entered.

Election/Restrictions

2. Claims 121, 122, 125, and 126 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 30 November 2001.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 67, 118, and 124 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claim 67 is confusing as to whether the “12 nucleotides” are consecutive or discontinuous with respect to the region that they are taken from SEQ ID NO:681.
6. Claim 67 is also confusing as there is no conjunctive or alternative operator between parts a) and b). Simply put, is it either a) “or” b); or a) “and” b)?
7. Claim 118 is confusing where the claim reads in part “or a portion which.” The claim contains multiple occurrences of “which.” It is not clear if this instance is to be directed to the nucleic acid or the polypeptide.
8. The term "stringent" in claim 124 is a relative term, which renders the claim indefinite. The term "stringent" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.
9. Claim 124 is confusing as to the number of nucleotide sequences being claimed. In the preamble of the claim the singular is used (sequence) yet in part b), the claim recites “nucleotide sequences.” It is unclear how a “sequence” has “sequences.”
10. Said claim 124, part b), is also confusing as to just what is to be encoding “a cancer associated antigen.” In particular, is it the claimed nucleic acid, or is it that to which it hybridizes?

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 67, 118, and 124 are rejected under 35 U.S.C. 102(b) as being anticipated by GIBCO BRL Products & Reference Guide ("GIBCO").

13. For purposes of examination, claims 67, 118, and 124 have been interpreted as encompassing virtually any complementary sequence of SEQ ID NO: 681, as well as virtually any sequence of same. In accordance with claim 67, and claim 118 which depends therefrom, the claimed isolated nucleic acid has been construed as having a length of at least 12 nucleotides.

14. As is readily apparent from SEQ ID NO: 681, the recited sequence comprises a run of at least 12 "a" residues; *infra*.

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agcaaaagaa acacagaaat ttaaatgcaa tgggagaaa tttttttttt 1740
tggttaactgc agtttggttg gttattcaat aaaagtttta gttttaaaaa aaaaaaaaaa 1745
aaaac
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GIBCO, page 16-13, lists for sale the complement of said sequence, an oligo(dT) sequence that ranges in length of 4 to 22 bases. Such a showing is considered to meet at least one limitation of said claims.

15. Claim 124 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,474,796 (Brennan).

16. For convenience, claim 124 is reproduced below.

124. (Previously presented) An isolated nucleic acid molecule comprising a nucleotide sequence selected from the group consisting of (a) SEQ ID NO:681, (b) nucleotide sequences which hybridize under stringent conditions to a nucleic acid molecule consisting of SEQ ID

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NO:681 and which code for a cancer associated antigen precursor, (c) nucleic acid molecules that differ from the nucleic acid molecules of (a) in codon sequence due to the degeneracy of the genetic code, and (d) complements of (a), (b), or (c).

17. For purposes of examination, claim 124 has been interpreted as encompassing virtually any nucleic acid sequence. It is noted with particularity that the claim does not recite any lower limit as to the length of the nucleic acid, nor does the claim recite the conditions that are to be equated with “stringent” hybridization conditions.

18. Brennan, column 9, discloses an array of isolated oligonucleotides that comprise all possible 10-mers. By default, the array of Brennan fairly encompasses all 10-mers, nucleotide sequences fairly encompassed by at least one part of claim 124.

19. For the above reasons, and in the absence of convincing evidence to the contrary, claim 124 is rejected under 35 USC 102(b) as being anticipated by Brennan.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, W. Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bradley L. Sisson
Primary Examiner
Art Unit 1634

BLS
02 February 2005